REMARKS

Claims 3-6, 8, 11-14 and 16-18 are pending in the present application. Claims 1-2, 7, 9-10, and 15 are canceled; and claims 3, 11, and 17 are amended in this response. Claims 3, 11, and 17 are amended to include the content of claims 2 and 10. Support for the amendments to claims 3, 11, and 17 is located at least on page 12, paragraph 31 through page 13, paragraph, 32. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Alleged Obviousness Based on *Colosso*, *Hecksel*, *Frison*, and *Horstmann*

The Office Action rejects claims 2-6, 8, 10-14, and 16-18 under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Colosso* (U.S. Patent 6,169,976 B1) in view of *Hecksel et al.* (U.S. Patent 6,151,707), hereinafter referred to as *Hecksel*, and further in view of *Frison et al.* (U.S. Patent 6,049,789), hereinafter referred to as *Frison*, and further in view of *Horstmann* (U.S. patent 6,009,401). This rejection is respectfully traversed.

As to independent claims 3, 11 and 17, the Office Action states:

> As per claim 3,
> Colosso ('976) discloses a method for updating a license period of a program; comprising:
> a step of issuing a request to an index server for transmission of an index file if a determination made by said first determination step is false; (Column 9, lines 16-29 [generating an account])
> a step of receiving the index file from said index server; (Column 11, lines 34-48; column 12 lines 19-37 [.. emails serial number and connection identifier])
> a step of receiving authentication information from said authentication server; (Column 15, lines 19-25 .. sends key information to the customer..)
> a second determination step of determining whether information indicative of success of authentication is contained in said authentication information; (Column 15, lines 45-60 [the customer is provided a second opportunity to enter valid information .. obviously this point would only be reached if the initial attempt of authentication was unsuccessful.])
> a step of updating the license period of said program if a determination made by said second determination step is true. (Column 16, lines 5-9 [stores the keys ..])
> Colosso ('976) does not specifically disclose a first determination step of determining whether a current date and time is within a license period of the program. Hecksel et al. ('707) discloses a first determination step of determining whether a current date and time is within a license period of the program. (Abstract [determining a current registration status based on a current data, a reference date, and conducting post registration activity based on the status of the program.]). It would have been obvious to one having ordinary skill in the art at

the time the invention was made to combine Colosso ('976) method with the Hecksel et al. ('707) method in order to determine the status of the license.

Colosso ('976) does not specifically disclose a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file; (Column 13, lines 7-19). Frison et al. ('789) discloses a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file (Figure 5, Column 3, lines 55-66 [... other information such as date, time, host, user ...]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Colosso ('976) method with the Frison et al. ('789) method in order to determine the status of the license.

Colosso ('976) does not specifically disclose wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server.

Horstmann '401 discloses wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server (column 5, lines 3-16 [ticket contains machine ID, and is decrypted by the product server]).]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Colosso ('976) method with the Horstmann ('401) method in order to protect the license information from tampering during transmission from server to client.

Claims 11 and 17 are in parallel with claim 1 and is rejected for at least the same reasons.

Office Action dated November 30, 2005, pages 2-3.

As amended, claim 3, which is representative of the other rejected independent claims 11 and 17 with regard to similarly recited subject matter, reads as follows:

3. A method for updating a license period of a program; comprising:

a first determination step of determining whether a current date and time is within a license period of the program;

a step of issuing a request to an index server for transmission of an index file if a determination made by said first determination step is false;

a step of receiving the index file from said index server;

a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file, wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server;

a step of receiving authentication information from said authentication server;

a second determination step of determining whether information indicative of success of authentication is contained in said authentication information; and

a step of automatically updating the license period of said program if a determination made by said second determination step is true, wherein said first determination step is performed upon activation of said program, and wherein

said program becomes executable after automatically updating said license period. (emphasis added)

As to independent claims 8, 16 and 18, the Office Action states:

> As per claim 8,
> Colosso ('976) discloses a method for licensing the use of a program comprising the steps of:
> receiving a request from a user; (Column 9, lines 16-29)
> Colosso ('976) does not specifically disclose creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request; wherein said address information contained in said index file is encrypted and, sending said index file to the user who issued said request. Horstmann '401 discloses wherein creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request; wherein said address information contained in said index file is encrypted and, sending said index file to the user who issued said request. (Column 5, lines 3-16 [ticket contains machine ID, and is decrypted by the product server]). It would have been obvious to one having ordinary skill in the art at the time the inventions was made to combine the Colosso ('976) method with the Horstmann ('401) method in order to protect the license information from tampering during transmission from server to client.
> Claims 16 and 18 are in parallel with claim 8 and are rejected for at least the same reasons.

Office Action dated November 30, 2005, pages 4-5.

Claim 8, which is representative of the other rejected independent claims 16 and 18 with regard to similarly recited subject matter, reads as follows:

> 8. A method for licensing the use of a program, comprising the steps of:
> receiving a request from a user;
> creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request, wherein said address information contained in said index file is encrypted; and
> sending said index file to the user who issued said request.
> (emphasis added)

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Colosso, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest "issuing an authentication request to an authentication server with an address of

the authentication server contained in said index file, wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server," as recited in claims 3, 11, and 17. Similarly, *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest "creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request, wherein said address information contained in said index file is encrypted," as recited in claims 8, 16, and 18. Additionally, *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, either taken alone or in combination, do not teach or suggest "automatically updating the license period of said program if a determination made by said second determination step is true, wherein said first determination step is performed upon activation of said program, and wherein said program becomes executable after automatically updating said license period," as recited in claims 3, 11, and 17.

Colosso is directed to a method and apparatus for activating, installing, and regulating the use of licensed products. A customer licenses or buys a licensed product from a distributor. The distributor registers information describing the customer, the licensed product, and other information about the transaction at a database maintained by the licensor, manufacturer, or developer of the licensed product. The licensor communicates information describing the transaction to the customer, and the distributor ships media containing the licensed product to the customer. The customer connects to the database through a server using a customer interface and requests the licensed product to be activated, providing the information that describes the transaction in its request. In response, the server of the licensor generates encrypted key information that uniquely identifies the customer, the licensed product, and a license level. The customer installs the licensed product and provides the key information during the installation process. The licensed product is then executed and the appropriate license level is enforced based on the key information. See *Colosso*, abstract. As stated in the Office Action, *Colosso* does not teach "a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file, wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server," as recited in claims 3, 11, and 17. Also as stated in the Office Action, *Colosso* does not teach "creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request, wherein said address information contained in said index file is encrypted," as recited in claims 8, 16, and 18.

Additionally, *Colosso* does not teach "a step of automatically updating the license period of said program if a determination made by said second determination step is true, wherein said first determination step is performed upon activation of said program, and wherein said program becomes executable after automatically updating said license period," as recited in claims 3, 11, and 17. In other words, when the expiration of a license period is determined upon activation of a program, the license period is automatically updated if the authentication from the authentication server is successful and then the program becomes executable. To the contrary, *Colosso* teaches that a customer reruns the installation program to replace a previously stored activation key with a new activation key for later use by the licensed product. See *Colosso* column 17, lines 20-35. Further, *Hecksel*, *Frison*, and *Horstman* do not provide for the deficiencies of *Colosso*.

Hecksel is directed to a system and method for product registration. A configurable registration profile defines a number of configurable post-registration activity periods with corresponding activities to tailor presentation and collection of information after software installation. *Hecksel* is cited for allegedly teaching a first determination step of determining whether a current date and time is within a license period of the program. *Hecksel* only teaches determining a current registration status of a software program based on a current date, a reference date, and a configurable post-registration activity period. *Hecksel's* post-registration activity period is not equivalent to a license period. *Hecksel* does not mention licensing, license management or a license period. Further, *Hecksel* does not provide for the deficiencies of *Colosso*.

Frison is directed to a software pay-per-use (PPU) licensing system. The PPU licensing system includes one or more licensor license management system (LMS) and one or more licensee LMS. Each licensee LMS includes one or more components that operate to grant pay-per-use licenses for software applications, including data collection on amount of usage licenses granted, and to monitor operational states of the pay-per-use license granting and data collection operations, including periodic reporting of state and usage license granted data to a licensor LMS. Each licensor LMS includes components that operate to receive, store and process state and usage license granted data for the software applications from the licensee systems, including verification of timely periodic reporting from the licensee LMS. See *Frison*, abstract. *Frison* is cited for allegedly teaching a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file. To the contrary, the cited portions of *Frison* only disclose a usage record containing information such as a host of the software application. The host of the software application is not the address of the authentication server. Thus, *Frison* does not provide for the deficiencies of *Colosso*.

Horstman is directed to a mechanism for use in conjunction with Electronic Software Distribution (ESD) that provides purchase documentation and that allows for convenient re-download and relicensing of soft-ware, including old software versions. In accordance with one embodiment of the invention, a relicensing manager software utility installed on an end user's machine interacts with one or more of a remote publisher site, a license clearing house and a merchant site to relicense, transfer, or obtain a refund for a software product. The role of the publisher site is to archive both current and old versions of software products. The role of the license clearinghouse is to keep a count of licensed installations and to grant or deny permission to relicense based on the count. The role of the product server is to effect a credit transaction and, according to the terms of the end-user license, to refund the purchase price of a recently purchased software product for which the customer has requested license revocation. The relicensing manager refers to a license certificate stored on the end user's machine during installation and, preferably, backed-up on floppy disk or some other permanent storage medium. The license certificate describes license policies and server locations, which are then followed by the relicensing manager. See *Horstman*, abstract. *Horstman* is cited for allegedly teaching "wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server." *Horstman* does disclose encrypting and decrypting a machine ID, which identifies the end user's machine, but this machine ID is not an address of an authentication server. Neither *Frison's* host of the software application nor *Horstman's* machine ID is an address of an authentication server. *Colosso*, *Hecksel*, *Frison*, and *Horstmann* do not teach or suggest "a step of issuing an authentication request to an authentication server with an address of the authentication server contained in said index file, wherein address information of said authentication server contained in said index file is encrypted, further comprising the step of decrypting the encrypted address information of said authentication server," as recited in claims 3, 11, and 17. In addition, *Colosso*, *Hecksel*, *Frison*, and *Horstmann* do not teach or suggest "creating or selecting an index file containing address information of a server that grants authentication regarding a license of the program to be used by the user in response to receipt of the request, wherein said address information contained in said index file is encrypted," as recited in claims 8, 16, and 18.

Colosso, *Hecksel*, *Frison*, and *Horstmann*, either taken individually or in combination, do not teach or suggest the features of independent claims 3, 8, 11, and 16-18. In addition, *Colosso*, *Hecksel*, *Frison*, and *Horstmann*, taken individually or in combination, do not teach or suggest the features of dependent claims 4-6 and 12-14 at least by virtue of their dependency on

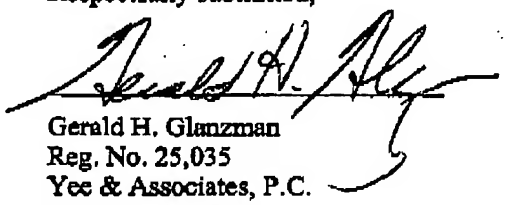
independent claims 3 and 11, respectively. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-6, 8, 11-14, and 16-18 under 35 U.S.C. § 103(a).

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: February 28, 2006

Respectfully submitted,



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